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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2001-0158.02

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on January 3, 2006

Signature

Ronald K. Aust

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Application Number

09/957,014

Filed

September 20, 2001

First Named Inventor

Richard Francis Russell

Art Unit

2142

Examiner

B. Prieto

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☐ attorney or agent of record.
Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 Reg. No. 36,735

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317-894-0801

Telephone number

January 3, 2006

Date

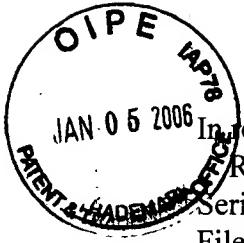
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of)
 Richard Francis Russell, et al.) Group: 2142
 Serial No.: 09/957,014)
 Filed: September 20, 2001)
 Title: AUTOMATIC REMOTE ASSIGNMENT OF INTERNET)
 PROTOCOL ADDRESS INFORMATION TO A NETWORK DEVICE) Examiner: B. Prieto

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Applicants hereby submit an Attachment to their Pre-Appeal Brief Request For Review.

Claims 1-25 are pending in the present patent application. Claims 1-25 stand rejected.

Applicants believe claims 1-25 patentably define their invention over the cited references, and that the rejection of claims 1-25 is clearly in error, for at least the reasons set forth below.

Claims 1, 9, 10, 17, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buse, et al., U.S. Patent No. 6,810,420 B1 (hereinafter, Buse) in view of Cheshire, S., Current Meeting Report, Cheshire, et al., 03/99 (hereinafter, Cheshire). Applicants have summarized Buse and Cheshire as set forth in Applicants' Reply under 37 C.F.R. 1.116, mailed August 17, 2005, as follows: Buse is summarized from the middle of page 7 through the top of page 8, and Cheshire is summarized at the upper half of page 8.

As set forth in Applicants' Reply under 37 C.F.R. 1.116, beginning at the middle of page 7 through the upper half of page 13, Applicants respectfully submit that claims 1, 9, 10, 17, and 25 are patentable over Buse in view of Cheshire.

Claim 1 is directed to a method of automatically assigning an internet protocol address to a device. Claim 1 recites, in part, providing a network adapter to communicatively couple said device to said network, said network providing communicative interconnection between said computer and said network adapter. Claim 1 also recites, in part, said computer performing the steps of: generating an internet protocol address; incorporating said internet protocol address in an address resolution protocol probe; sending said address resolution protocol probe on said network; and determining whether a response to said address resolution protocol probe indicates that said internet protocol address is in use; wherein if said internet protocol address is not in use,

then performing the step of assigning said internet protocol address to said network adapter via said network.

In contrast to claim 1, Buse discloses (1) obtaining an IP address via either a DHCP request or Automatic Private IP addressing, wherein (2) it may be verified that there is no address conflict using address resolution protocol or an ICMP echo request (col. 3, lines 37-41), and (3) providing the device with an address. The method disclosed by Buse clearly does not provide an IP address by (1) generating an IP address; (2) incorporating the IP address in an ARP probe; (3) sending the ARP probe on the network; (4) determining whether a response to the ARP probe indicates that the IP address is in use; and (5), assigning the IP address to the network adapter via the network if the internet protocol address is not in use, as recited in claim 1. Accordingly, Buse does not disclose, teach, or suggest the subject matter of claim 1.

With respect Cheshire, in contrast to configuring another device over a network, e.g., the method of automatically assigning an internet protocol address to a device, *wherein a network provides communicative interconnection between the computer and the network adapter*, as recited in claim 1, Cheshire clearly discloses a device that configures itself, i.e., a computer that obtains an IP address for that computer itself, i.e., for that same computer to employ for network communication, which is well known in the art as self-configuration, wherein a computer includes a network adapter directly connected to and part of the “computer” itself, for example, usually housed within the physical package referred in the art to as a “computer, and is employed for network communication. Thus, Cheshire teaches self configuration, as opposed to providing an IP address for another device, separate and distinct from the computer that obtains the IP address, which is connected via a network to the computer that obtains the IP address.

Accordingly, Cheshire does not disclose, teach, or suggest the subject matter of claim 1.

Further, it would not be obvious to combine the teachings of Buse and Cheshire to achieve Applicants’ invention of claim 1, i.e., to combine self-configuration, as disclosed by Cheshire, with the allocation of IP addresses by proxy, as disclosed by Buse, in order to achieve Applicants’ claimed invention, at least for the reason that there would be no motivation to modify Buse with Cheshire, since each is a different approach in obtaining IP addresses.

Although the Examiner asserts that the motivation may be found in either the references themselves or knowledge generally available to one of ordinary skill in the art, relying upon *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), the Examiner has not provided particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected

the particular components from Cheshire and Buse for combination in the manner claimed. There was no specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Applicants' invention to make the combination in the manner of claim 1. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In Re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In addition, prior art references in combination do not make the invention obvious unless something in the prior art references would suggest an advantage to be derived from combining their teachings. *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983). See also *In re GPAC*, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). However, neither Buse nor Cheshire disclose, teach, or suggest an advantage to be derived from combining their teachings.

Further, Applicants submit that the asserted combination is based on impermissible hindsight reconstruction. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Buse is directed to configuration by proxy, whereas Cheshire is directed to self-configuration. Since, as set forth above, there is no advantage disclosed, taught, or suggested by either of the references to modify Buse with Cheshire, and no asserted principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Applicants' invention to make the combination, it seems clear that hindsight reconstruction has been employed in rejecting Applicants' claims.

Accordingly, claim 1 is not obvious over Buse in view of Cheshire.

Regarding claim 17, Applicants submit that Buse in view of Cheshire does not disclose, teach, or suggest all of the claim 17 limitations, such as an imaging device; and a network adapter communicatively coupling the imaging device to the network, the network providing communicative interconnection between the computer and the network adapter.

The Examiner asserts that, given a broad interpretation, "imaging device" is simply a "device." However, the Patent and Trademark Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004), *Phillips v. AWH Corp.*, 75 USPQ2d 1321, 415 F.3d 1303 (Fed. Cir. 2005).

Applicants specification provides that network device 14 may be an imaging device, such as a printer (p.3, l.20). In interpreting "imaging device" to include any "device" generally, the

Examiner has truncated Applicants' chosen term, and simply removed the word, "imaging," along with the meaning that "imaging" imports to "imaging device." Interpreted in light of Applicants' specification, one of ordinary skill in the art would not interpret "imaging device" broadly enough to encompass any "device." Rather, an imaging device is known in the art to pertain to, e.g., a printer, a copier, an all-in-one unit that combines printing, copying, and faxing, etc., and the like.

In addition, claim 17 is believed allowable for substantially the same reasons as set forth above with respect to claim 1, and claim 25 is believed allowable at least due to its dependence on otherwise allowable base claim 17.

Claims 2-6 and 18-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buse in view of Cheshire, and in further view of Reed, et al., U.S. Patent No. 6,061,739 (hereinafter, Reed). Reed is summarized in Applicants' Reply under 37 C.F.R. 1.116, from the bottom of page 13 through the top of page 14. As set forth in Applicants' Reply under 37 C.F.R. 1.116, beginning at the bottom of page 13 through page 16, Applicants respectfully submit that claims 2-6 and 18-22 are patentable over Buse in view of Cheshire, and in further view of Reed.

Like Cheshire, Reed is directed to self-configuration. For substantially the same reasons as set forth above with respect to claim 1, it would not be obvious to combine the teachings of Buse, Cheshire, and Reed to achieve Applicants' invention of claims 2-6 and 18-22.

Claims 7, 11-16, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buse in view of Cheshire, and in further view of Mellquist, U.S. Patent No. 6,115,545. Mellquist is summarized in Applicants' Reply under 37 C.F.R. 1.116, on page 17. As set forth in Applicants' Reply under 37 C.F.R. 1.116, beginning at the bottom of page 16 through the lower middle portion of page 21, Applicants respectfully submit that claims 7, 11-16, and 23 are patentable over Buse in view of Cheshire, and in further view of Mellquist.

Like Cheshire, Mellquist is directed to self-configuration. For substantially the same reasons as set forth above with respect to claim 1, it would not be obvious to combine Buse, Cheshire, and Mellquist to achieve Applicants' invention of claims 7, 11-16, and 23.

Claims 8 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buse in view of Cheshire, in further view of Mellquist, and in further view of Troll, Request for Comments: 2563, May 1999, Troll R. Troll is summarized in Applicants' Reply under 37 C.F.R. 1.116 beginning at the bottom of page 21 through the top of page 22. As set forth in Applicants' Reply under 37 C.F.R. 1.116, beginning at the bottom of page 21 through page 24, Applicants respectfully submit that claims 8 and 24 are patentable over Buse in view of Cheshire, in further

view of Mellquist, and in further view of Troll.

Like Cheshire and Mellquist, Troll is directed to self-configuration. For substantially the same reasons as set forth above with respect to claim 1, it would not be obvious to combine Buse, Cheshire, Mellquist, and Troll to achieve Applicants' invention of claims 8 and 24.

In addition, the fact that four references were combined in rejecting claims 8 and 24, especially given that the primary reference pertains to the allocation of IP addresses by proxy, whereas the additional three references pertain to self configuration, which relates to a different problem than allocation of IP addresses by proxy, is tantamount to hindsight reconstruction of Applicants' invention. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, all dependent claims are believed allowable due to their dependence on otherwise allowable respective base claims.

For the foregoing reasons, Applicants submit that the present application is in condition for allowance in its present form, and request that a Notice of Allowance be issued in due course.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,



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Registration No. 36,735

Attorney for Applicants

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: January 3, 2006

Ronald K. Aust, Reg. No. 36,735

Name of Registered Representative



Signature

January 3, 2006

Date

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